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EXAMINER

LERNER, AVRAHAM H

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/733,626

Applicant(s)

BARBIERI ET AL.

Examiner

Avraham Lerner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-48 and 52-99 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,9,13-15,17-20,24-45,53-75 and 79-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,10-12,21-23,46-48,52 and 76-78 is/are rejected.
- 7) ☒ Claim(s) 5,6 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 48, 52, and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response to the restriction requirement between one embodiment of the present invention teaching rigid spacers and a second embodiment teaching a spring biased hinge used as a spacer, applicant elected the embodiment having rigid spacers. Applicant also stated that claims 48, 52, and 77 read on the elected embodiment, and therefore do not include a spring-biased hinge. Claims 52 and 77 include a limitation reciting that the spacer is constructed so as to allow movement of the deck and runner toward each other to decrease the distance between the two, and claim 48 recites that at least one of first and second upturned runner ends is constructed to contact the deck while the device is being ridden. These claims are indefinite in that it is unclear how these limitations could be consistent with the remainder of the claims from which they depend, and specifically given applicant's election of the embodiment having only rigid spacers.

*Withdrawal of allowable subject matter*

3. The indicated allowability of claim 2 is withdrawn in view of the newly discovered reference to Moore et al. (U.S. Patent No. 5,765,854). Rejections based on the newly cited reference follow.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 7, 10-12, 21, 22, 46, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore et al. (U.S. Patent No. 5,765,854).

Moore et al. discloses a sliding device (see Fig. 7 and/or Fig. 14) comprising all elements as claimed, including a runner (34) having first and second upturned ends and a middle portion; a deck (81) elevated from the runner, the deck having an upper surface for supporting a rider; a spacer (218) secured to the runner and deck as claimed so that forces applied by a rider on the deck are transmitted to the runner; wherein one or both of the runner and the deck is arranged and mounted to the spacer to allow longitudinal movement of either the runner or the deck relative to the other, and wherein the runner and deck are constructed and arranged to provide equivalent riding performance with the first runner end forward and the second runner end forward, the runner and deck allowing adjustment of the position of the spacer relative to the runner or deck, the device having first and second spacers, and wherein the first and second spacers are separated longitudinally by a distance equal to approximately zero to three-fifths the

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overall length of the runner; a portion of the runner between the spacers being free to flex relative to the deck, and at least one of the upturned ends being free to flex.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23, 76, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al.

Moore et al. discloses a device comprising all elements as claimed, as recited above in detail, except for explicitly teaching that the ratio of overall deck length to the overall runner length is at least .75, and that the overall runner length and overall deck length differ by at most 13 inches. However, it would have been obvious to one of ordinary skill in the art to decrease the length of the runner such that the lengths of the deck and runner conform to applicant's capricious size ratios. Such a modification to decrease the overall length of the runner would have enabled a user more control over the monoski, in that a shorter runner length provides a more easily turned and controlled device as a whole. Note that a change in size of a component is generally recognized as being within the level of ordinary skill in the art, in particular when there is a known benefit to the change. *In re Rose*, 105 USPQ 237 (CCPA 1955).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore et al. in view of Trimble (U.S. Patent No. 5,413,371).

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Moore et al. discloses a device comprising all elements as claimed, as recited above in detail, except for “a foam material secured to at least one portion of the upper surface of the deck”, instead disclosing that the binding plate attached to the upper surface is “made of a material, or a combination of materials, such as metal, plastic, or even wood, which have a sufficient strength to maintain structural integrity in light of the various mounting structures 83, 84 formed in the plate.” See column 6, lines 62-66.

Trimble discloses that it is known in the art to make a binding block out of high-strength foam, and specifically recites that such an element can easily be substituted with or modified to include a hard relatively stiff plastic, demonstrating that the two materials are known in the art to be usable together or to be exchanged for one another in a particular environment.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the binding plate out of a high-strength foam material in order to provide a binding which, as taught by Trimble, “is lightweight and compressive in order to absorb vibration”. Such a modification to a known equivalent would therefore have been obvious to one of ordinary skill in the art, and further the selection of a known material for its suitability for the intended use does not serve to define over the references. See *In re Leshin*, 125 USPQ 416.

#### ***Allowable Subject Matter***

9. Claims 5, 6, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Powell (U.S. Patent No. 4,674,765) discloses a ski (see Fig. 3) having a runner, a spacer, and a deck, but does not show first and second upturned ends on the runner. Bobrowicz (U.S. Patent Application Publication No. 2003/0160404 A1) discloses a runner having a deck and rigid spacers.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avraham Lerner whose telephone number is (703) 308-0423. The examiner can normally be reached on M-F (8:15-5:45) first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**AVRAHAM LERNER**  
**PRIMARY EXAMINER**

*A. Lerner* 3/15/04

March 15, 2004